

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

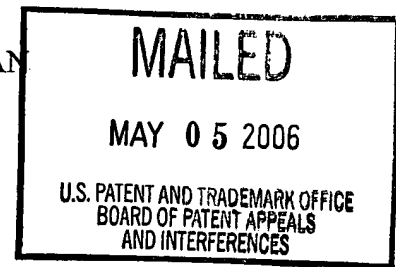
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: NEELAKANTAN SUNDARESAN

Appeal No. 2006-1342
Application No. 09/488,471

ON BRIEF



Before KRASS, SAADAT and MACDONALD, **Administrative Patent Judges**.
KRASS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-32.

The invention pertains to integrating various sources for rating businesses with on-line search engines so that matches to a user query regarding businesses are reordered in order to rank the search results with regard to higher business satisfaction ratings.

Representative independent claim 1 is reproduced as follows:

1. A self-correcting system for use with a search engine to rank search results based upon a ranking of businesses that are selected from an unrestricted pool of merchants, comprising:

an off-line ranking system for receiving any of users' off-line surveys or feedback about businesses;

the off-line ranking system generating rating data from the any of the users' off-line surveys or feedback;

wherein the rating data correlates higher quality search matches to higher business satisfaction ratings;

wherein the off-line ranking system indexes the rating data;

a ranking repository for storing the rating data indexed by the off-line ranking system;

a result sorter for sorting query results generated by the search engine, based on the rating data from the ranking repository, and for generating ranked matches;

a profile manager for creating a user profile history from a user's address;

wherein the user profile history enables the user to update a rating that was previously provided by the user, and disables the user from revising ratings provided by other users; and

wherein updated cumulative business satisfaction ratings from the users' off-line surveys or feedback automatically cause the off-line ranking system to re-index the rating data, and further cause the result sorter to generate ranked matches based on the re-indexed rating data.

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The examiner relies on the following references:

Peters et al. (Peters) 5,893,098 Apr. 6, 1999

BizRatecom, Making the Web a Safer, Better Place to Shop!
<http://web.archive.org/web/19981205082910/http://bizrate.com/>
copyright 1997, 1998 Binary Company Enterprises, pages 1-29

In addition, the examiner relies on admitted prior art [APA] at pages 1-3 of the instant specification.

Claims 1, 9, 17, and 25, all of the independent claims, stand rejected under 35 U.S.C. §112, first paragraph, as relying on an inadequate written description.

Claims 1-32 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers BizRate and Peters with regard to claims 1, 2, 6-10, 14-18, 22-26, and 30-32, adding APA with regard to claims 3-5, 11-13, 19-21, and 27-29.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

First, it is acknowledged that the decision in Serial No. 09/488,470 (Appeal No. 2005-2756), decided February 27, 2006, is highly relevant to the instant appeal, because it has a direct affect and bearing on the Board's decision in the instant case. The rejections are the same, the references are the same and the only difference in the claims is in the recitation of "on-line sources" in application Serial No. 09/488,470 and "off-line sources" in the instant application.

Turning first to the rejection under 35 U.S.C. §112, first paragraph, the examiner asserts that the features, “businesses that are selected from an unrestricted pool of merchants” and “updated cumulative business satisfaction ratings from the users’ off-line surveys or feedback automatically cause the off-line ranking system to re-index the rating data,” were not described in the specification and are considered new matter unsupported by the instant disclosure.

The written description requirement is separate from the enablement requirement of 35 U.S.C. 112. It is not necessary that the claimed subject matter be described identically, but that the originally filed disclosure convey to those skilled in the art that appellant had invented the subject matter now claimed. Precisely how close the original description must come to comply with the description requirement must be determined on a case by case basis as a question of fact.

In re Barker, 559 F.2d 588, 591, 194 USPQ 470 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978), sub. nom., Barker v. Parker, 434 U.S. 1064, 197 USPQ 271 (1978); In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985), sub. nom.; Wilder v. Mossinghoff, 469 U.S. 105, 105 S. Ct. 1173 (1985).

The test for written description is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). An invention claimed need not be described *ipsis verbis* in the specification in order to satisfy the

disclosure requirements of 35 U.S.C. 112. Ex parte Holt, 19 USPQ2d 1211(Bd Pat App & Inter, 1991).

The claimed “businesses that are selected from an unrestricted pool of merchants” is said by appellant to be supported by the disclosure of a business rating system described in connection with the WWW (p. 6, ln.7-8; p. 9, ln. 16-17), so that “absent a clear indication to the contrary, it should be quite clear to person of ordinary skills in the art that the businesses on the Internet are part of an unrestricted pool of merchants” (principal brief-page 9). The examiner counters that even if WWW constitutes an unrestricted pool of merchants, there is still no description of “businesses that are selected” from an unrestricted pool of merchants as claimed.

We agree with appellant. The specification (p.9, ln. 16-17), as originally filed, discloses that the business rating system is described in connection with the WWW. Thus, it is evident and would have been to artisans at the time of the instant invention, the WWW constitutes an “unrestricted pool of merchants,” and that certain of these businesses would be “selected” for ranking based on a user’s query over the WWW. It is thus clear to us that appellant had possession of the ranking of businesses that are selected from an unrestricted pool of merchants, as now claimed, at the time of filing the instant application.

Turning to the claimed feature of “updated cumulative business satisfaction ratings from the users’ on-line surveys or feedback automatically cause the on-line ranking system to re-index

the rating data,” appellant argues that this feature is “inherent” in that as new satisfaction ratings are collected by the users. These new ratings form the updated cumulative business satisfaction ratings, which when queried by another user are indexed again, i.e., re-indexed. The examiner questions how it should be understood that the indexing process of the rating data is a continuous, automatic process and the rating data are not indexed once and the process stops.

It is appellant’s position that it would not be logical to imply, as the examiner does, that data is indexed once and the process stops. Logical or not, if the original disclosure provides for this in the description and does not provide for updated cumulative business satisfaction ratings, causing a re-indexing, then appellant would have failed to show that he had possession of the invention, as now claimed, at the time of originally filing the application.

At page 15, lines 7 et seq., the original disclosure describes a “self correcting system” in the sense that “after a certain period of use, the users’ interactive ratings could significantly affect the ranking of the businesses, and ultimately, lower ranked businesses stand lower chances of being browsed and thus selected.” If data is indexed once and then the process is stopped, this would not be a “self correcting” system, as described and claimed. By the description of the specification (p.15), of ranking being significantly affected “after a certain period of use,” it appears clear to us that there is support in the original disclosure for updating cumulative business satisfaction ratings, causing a re-indexing, as now claimed. Moreover, the disclosure

(p. 11-12) of the specification, regarding the submission of “new rating information” which will be “integrated with the rating data already stored in the on-line ranking repository...for use in subsequent searches” also points to appellant being in possession, at the time of filing the instant application, of updating cumulative business satisfaction ratings and re-indexing such ratings.

Accordingly, we agree with appellant that there is adequate support for the instant claimed subject matter, within the meaning of 35 U.S.C. §112, first paragraph, and we will not sustain the rejection of claims 1, 9, 17, and 25 under 35 U.S.C. §112, first paragraph.

We turn now to the rejection of the independent claims under 35 U.S.C. §103.

It is the examiner’s position (answer-pages 4-8) that BizRate discloses the claimed subject matter but for the step of indexing the rating data, storing the rating data indexed by the off-line ranking system, and updating cumulative business satisfaction ratings from the users’ off-line ranking system, or feedback automatically causing the off-line ranking system to re-index the rating data and further cause the result sorter to generate ranked matches based on the re-indexed rating data. However, contends the examiner, Peters provides for this deficiency at column 2, line 45 - column 3, line 16, column 4, lines 28-30, column 19, lines 46-57, column 21, line 65 - column 22, line 13, column 30, lines 12-19, and column 26, lines 43-50 (see answer-pages 7-8).

The examiner concludes that it would have been obvious to modify the BizRate system by indexing the rating data and storing the rating data that were indexed in a data repository as taught by Peters in order to update and retrieve the rating data of a business survey (answer-p. 8).

We have reviewed the evidence before us, including the applied references, the arguments of appellant and the examiner, and we conclude that the examiner has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C. §103. Accordingly, we will not sustain the rejection of claims 1-32 under 35 U.S.C. §103, based on the BizRate and Peters references.

In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under §103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

To reach a proper conclusion under 35 U.S.C. § 103, the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether the claimed invention as a whole would have been obvious at *that* time to *that* person. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts.

The test for obviousness is based on the claimed invention as a whole and not upon mere combination of prior art references. Creative Pioneer Products Corp. v. K Mart Corp., 1987 WL 54482 (S.D. Tex), 5 USPQ2d 1841 (DC S.Texas 1987).

The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617.

Applying these principles to the instant rejection, we note that the examiner admits that BizRate is deficient in teaching an indexing of the rating data, storing the rating data indexed by the off-line ranking system, updating cumulative business satisfaction ratings from the users' off-line ranking system, and automatically causing the off-line ranking system to re-index the rating data and further causing the result sorter to generate ranked matches based on the re-indexed rating data. In fact, BizRate appears to have a very meager disclosure of the means for causing many of its disclosed functions. It does, however, clearly suggest the general idea of the rating of merchants by customers and the display of those ratings on the WWW to interested customers or potential customers.

Thus, taking independent claim 1 as exemplary, BizRate teaches a system for use with a search engine to rank search results based upon a ranking of businesses that are selected from an unrestricted pool of merchants. Appellant argues that the reference does not teach basing the ranking on an "unrestricted pool of merchants" because the reference is concerned only with certain merchants, citing, at page 8 of the examiner's copy of the reference of record, "we don't want to list every merchant on the Web, only those that can serve you best!" However, we agree with the examiner that the original pool of merchants from which BizRate selects is from the WWW and is as "unrestricted" as appellant's pool. If BizRate chooses to eliminate certain ones of merchants and rank only those in the pool of merchants chosen from the original unrestricted pool, that is BizRate's choice, but that selection is originally made from the unrestricted pool of

merchants on the WWW. In any event, it would have been obvious to the artisan to limit the pool of merchants to the “unrestricted” pool of merchants on the WWW or to any smaller subset of that unrestricted pool.

Moreover, it is clear that the customers in BizRate provide surveys or feedback (whether on-line or off-line) about the businesses they rate and that this information is received by the ranking system in BizRate which then generates rating data from those surveys/feedback. These ratings correlate higher quality search matches to higher business satisfaction ratings.

However, as far as the claimed subject matter is concerned, this is as far as we can take BizRate. We must look to Peters, in accordance with the examiner’s rejection, for the omitted claimed subject matter, e.g., for the indexing of the rating data, storage of the indexed rating data, and updating of cumulative business satisfaction ratings to automatically cause the off-line ranking system to re-index the rating data.

Peters deals with processing large amounts of data obtained from opinion polls by electronic mail for marketing purposes (column 1, lines 50-51; column 2, lines 48-55). A database is created for storing information, e.g., e-mail addresses of respondents (column 4, lines 28-30). Peters mentions an “index on the database” (column 30, line 13) and discloses a collator of survey information updating the database with answers to a survey (column 22, lines 12-13).

However, taking Peters as a whole, there is no indication that the “index” referred to at column 30 has any resemblance to the claimed feature of indexing “rating data.” Further,

whereas survey information may be updated in Peters by a collator, there is no indication in the reference that updated information relates to ratings and/or that such updates automatically cause an off-line ranking system to “re-index the rating data,” and/or cause a result sorter to generate ranked matches based on the re-indexed rating data, as required by the instant claims.

It is true that the examiner relies on BizRate for the claimed “rating data,” but since Peters does not seem to be concerned with such data, the question arises as to why the skilled artisan would have been led to apply any of the teachings in Peters to the business rating system of BizRate. Moreover, since the indexing of data in Peters does not appear to be similar to the indexing feature of the instant claimed invention and BizRate clearly suggests nothing in the way of indexing, as claimed, it must be asked why the skilled artisan would have applied any indexing of the rating data in BizRate.

Moreover, we find nothing in Peters related to the claimed “re-index” of rating data. The examiner appears to rely on column 26, lines 43-50, for this feature but reference to that portion of Peters reveals only updating of a respondent’s answer information.

While our list of the deficiencies of the applied references is not exhaustive, it is clear that the proposed combination lacks many of the claimed elements. Moreover, as mentioned supra, we find inadequate motivation for making the examiner’s proposed combination. But

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even if the proposed combination was somehow made, it would still not result in the instant claimed subject matter as a whole and the examiner has not convinced us otherwise.

We also note that in response to appellant's argument (principal brief-page 16), the claimed system is "automatic." The examiner's response (answer-page 16) was that this argument "does not relate to the claimed subject matter." However, it is clearly recited in the independent claims (e.g., claim 1, line 22), that updated cumulative business satisfaction ratings from users' surveys "automatically cause the off-line ranking system to re-index the rating data...." Accordingly, the examiner's response is not well taken.

Since APA does not supply the deficiencies as noted supra, we also will not sustain the rejection of claims 3-5, 11-13, 19-21, and 27-29 under 35 U.S.C. §103.

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Since we have not sustained any of the rejections of claims 1-32 under 35 U.S.C. §103 and we have not sustained any of the rejections of claims 1, 9, 17, and 25 under 35 U.S.C. §112, first paragraph, the examiner's decision is reversed.

REVERSED

Em A. Koon

ERROL A. KRASS
Administrative Patent Judge

Mahmud D. Qadab

MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Allen R. MacDonald

ALLEN R. MACDONALD
Administrative Patent Judge

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